AF / AU 1648 #41

PATENT
Attorney Docket No. 3495.0004-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Luc MONTAGNIER et al.	)	Group Art Unit: 1648
	)	
Serial No.: 08/067,148	)	Examiner: J. Parkin
	)	
Filed: May 26, 1993	)	

For: ANTIBODIES WHICH BIND WITH PROTEINS OF HUMAN IMMUNODEFICIENCY VIRUS TYPE 1 (HIV-1), AND IMMUNE COMPLEXES COMPRISING PROTEINS OF HIV-1 (As Amended)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMBINED PETITION: PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT UNDER 37 C.F.R. §1.181 AND RENEWED PETITION UNDER 37 C.F.R. §1.182

Pursuant to 37 C.F.R. § 1.181, applicants hereby respectfully petition the Assistant Commissioner to withdraw the holding of abandonment for the above-referenced application that was mailed on June 30, 1998. Applicants respectfully submit that the holding of abandonment is in error.

In the Decision on Petition and Notice of Abandonment mailed June 30, 1998 (Paper No. 39), the Special Projects Examiner denied applicants' Petition filed June 3, 1998, under 37 C.F.R. § 1.182 requesting withdrawal of a Terminal Disclaimer, and held that this application was abandoned for failure to file an Appeal Brief by a deadline of July 12, 1995. As the following discussion and the accompanying documents demonstrate, applicants filed a fully responsive Amendment and Petition for Extension of Time in lieu of an Appeal Brief.

LAW OFFICES
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, D. C. 20005
202-408-4000

Applicants timely filed a Notice of Appeal on January 12, 1995. A petition for a three-month Extension of Time to file an Appeal Brief was submitted on June 7, 1995, a copy of which is attached. A copy of postcard stamped by the U.S. Patent and Trademark Office is also attached as *prima facie* evidence of the receipt of this Petition in the U.S. Patent and Trademark Office on June 7, 1995. This extended the due date for the Appeal Brief from March 12, 1995 to June 12, 1995.

Applicants subsequently filed a Request for Reexamination after Final Rejection under 37 C.F.R. § 1.129, another Petition for a fourth-month Extension of Time, and an Amendment on July 11, 1995, copies of which are attached. This second Petition extended the period for filing the Appeal Brief to July 12, 1995. A copy of postcard stamped by the U.S. Patent and Trademark Office is also attached as *prima facie* evidence of the receipt of these items in the U.S. Patent and Trademark Office on July 11, 1995, the day before the brief was due.

According to 37 C.F.R. § 1.129:

> An applicant in an application, other than for reissue or a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), is entitled to have a first submission entered and considered on the merits after final rejection under the following circumstances: The Office will consider such a submission, if the first submission and the fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r).

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, D.C. 20005
202-408-4000

Applicants submit that the above-referenced application, filed May 26, 1993, meets the criteria for transitional practice under 37 C.F.R. § 1.129. Therefore, applicants respectfully submit that the finality of the final rejection of the Office Action of June 12, 1994, was automatically withdrawn upon the timely filing of the submission of the Request for Reexamination after Final Rejection under 37 C.F.R. § 1.129 filed July 11, 1995, and that an Appeal Brief was no longer required.

The Office even acknowledged receipt of the Request for Reexamination after Final Rejection under 37 C.F.R. § 1.129 filed July 11, 1995. See Paper No. 25 at 2, first paragraph. Accordingly, applicants respectfully submit that the application could not be abandoned on July 12, 1995, as indicated in the Notice of Abandonment mailed June 30, 1998, and respectfully request that the holding of abandonment for the application be withdrawn.

Pursuant to 37 C.F.R. § 1.182, applicants hereby respectfully request that the Assistant Commissioner reconsider the Petition for Withdrawal of Recorded Terminal Disclaimer filed on June 3, 1998.

Applicants submit that, in Paper No. 36, the Examiner rejected claims 15-20 as being unpatentable over claims 6, 10-13, and 18-22 of U.S. Patent No. 5,135,864 ("the '864 patent") and claims 4, 5, 7, and 9-11 of **U.S. Patent No. 5,217,861 ("the '861 patent")**. Applicants note that the Examiner raised this issue in Paper No. 36 stating: "It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to generate

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, D.C. 20005
202-408-4000

antibodies against these proteins to facilitate the detection of HIV-1. One of ordinary skill in the art would be motivated to use these antibodies either alone, or in combination, for diagnostic purposes." Paper No. 36 at 4. Since obviousness-type double patenting of claims 15, 16, and 18, and 19 over the '861 patent is currently an issue raised by the Examiner in the application, applicants respectfully submit that any decision by the Assistant Commissioner will not reopen the question of the propriety of this rejection. Moreover, applicants respectfully submit that withdrawal of the previously filed Terminal Disclaimer for the **'861 patent** will not usurp the functions or impinge upon the jurisdiction of the Board, as suggested in the Decision on Petition. (Paper No. 39 at 2.) In fact, the withdrawal of the previously filed Terminal Disclaimer would still require a decision by the Examiner on the merits of the outstanding rejection.

Applicants respectfully submit that it would be unfair for applicants to argue successfully that the claims in the instant application are not obvious over the '861 patent in response to the Examiner's rejection, but still be forced to retain a Terminal Disclaimer that was submitted solely to overcome the same rejection. Therefore, applicants respectfully request the withdrawal of the Terminal Disclaimer for U.S. Patent 5,217,861 filed May 4, 1994.

Furthermore, the Examiner raised the issue of obviousness-type double patenting of claims 18-20 over **U.S. Patent 5,217,864 ("the '864 patent")** in Paper No. 36 stating: "It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to generate antibodies against these proteins to facilitate the detection of HIV-1. One

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, D. C. 20005
202-408-4000

of ordinary skill in the art would be motivated to use these antibodies either alone, or in combination, for diagnostic purposes." Paper No. 36 at 3. Therefore, the reasons given for the obviousness-type rejection over the '864 patent and the '861 patent are identical. Applicants respectfully submit that applicants have been placed in the position of traversing the rejection of claims over the '864 patent, and since the reasons given by the Office in making this rejection are the same for the '861 and '864 patents, applicants must address the reasons given by the Office for obviousness-type double patenting, regardless of the Terminal Disclaimer for the '861 patent.

In applicants' Amendment and Response to Paper No. 36 filed June 3, 1998, applicants traversed the rejections stating on pages 8-9: "It is art recognized that antibodies and proteins are distinct subject matter. Therefore, applicants submit that the claims in the instant application and the claims in the '864 and '861 application are patentably distinct." As can be seen from applicants' response, applicants are faced with a similar issue of obviousness-type double patenting with respect to both the '861 and '864 patents. Applicants respectfully submit that it would be unfair for applicants to argue successfully that the claims in the instant application are not obvious over the '864 patent (and '861 patent), but still be forced to retain a Terminal Disclaimer. Therefore, applicants respectfully request the withdrawal of the Terminal Disclaimer for U.S. Patent 5,217,861 filed May 4, 1994, so that the issue of double patenting can be reconsidered in light of the new rejection with the application in the posture it was in regarding this issue in 1994, before the Terminal Disclaimer was filed.

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, D.C. 20005
202-408-4000

Should the Assistant Commissioner still feel that withdrawal of the previously-filed Terminal Disclaimer for the '861 patent would usurp the functions or impinge upon the jurisdiction of the Board, applicants respectfully request that a decision on the Petition for Withdrawal of Recorded Terminal Disclaimer be held in abeyance pending a decision on the merits of the obviousness-type double patenting of the pending claims over the '861 and '864 patents.

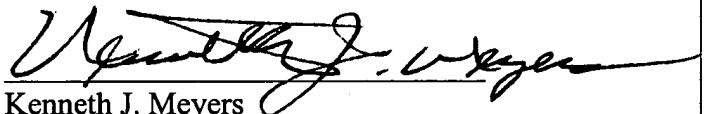
This Petition is being submitted prior to allowance of the application.

According to the fee schedule set forth in 37 C.F.R. § 1.17(h), the required fee of $130.00 for consideration of this Petition is enclosed herewith.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested, and the fee should also be charged to our Deposit Account.

Respectfully Submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



Kenneth J. Meyers
Registration No. 25,146

Dated: August 28, 1998

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, D.C. 20005
202-408-4000